

REMARKS

Claims 23, 24, 47, 48, 71, 72, 95 and 96 are pending in the present application. Claims 23, 47, 71 and 95 have been amended herewith. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph

The Examiner rejected Claims 23, 47, 71 and 95 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

The Examiner states that "the set of items" lacks proper antecedent basis. Applicants have amended such claims to correct this antecedent basis issue.

Therefore the rejection of Claims 23, 47, 71 and 95 under 35 U.S.C. § 112, second paragraph has been overcome.

II. 35 U.S.C. § 102, Anticipation

The Examiner rejected Claims 23, 47, 71 and 95 under 35 U.S.C. § 102(e) as being anticipated by Hare et al. (US 6,850,900). This rejection is respectfully traversed.

The present invention is directed to an improved method, and associated system and program product, for generating a customized catalogue by a user for subsequent use by an entity or organization. Pluralities of items are presented to a user, who selects certain ones of such items to generate a customized catalogue. Terms for purchasing items in this customized catalogue are then negotiated, and a protocol for purchasing items in this customized catalogue is established. While the cited reference is generally directed to an on-line business-to-business operation with a catalogue, the specifics of how this catalogue is generated/used are substantially different from the present invention, as will now be described in detail.

For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Applicants urge that every element of the claimed invention recited in Claim 23 is not identically shown in the cited Hare reference. In particular, the cited reference does not teach the claimed steps of a method *in a first data processing system* for generating a customized catalog, the method comprising (i) presenting a plurality of items to a

user located at a *second data processing system*; placing an item from the plurality of items in a set in response to a selection of the item by the user; generating the customized catalog in response to a request indicating that the set is complete; and *negotiating terms for purchasing items in the customized catalog*. As can be seen, the customized catalog is first generated in a first data processing system, by a user placing items presented to them at a second data processing system. Terms for purchasing items in this generated customized catalog are then negotiated. Because the claim explicitly states terms for purchasing items in the 'customized catalog' are negotiated, it necessarily follows that the customized catalog must exist at the time of such negotiation. Because the catalog is generated at the first data processing system and the user is presented with items at the second data processing system, it is the potential buyer who is generating the customized catalog. Applicants have amended Claim 23 to further emphasize this distinction (Specification support for such amendment is shown to be at least at page 10, lines 17-25). The teachings of the cited reference are substantially different, in that a catalog is first generated by a supplier (col. 16, lines 16-27; col. 58-65), not a buyer/purchaser, and then contract negotiations with a buyer occur. The buyer/purchaser can only create/review/approve/edit/send a contract, but does not specify items to be included in a customized catalog. It is noted that the buyer can edit this customized catalogue to perform such functions as making line level rejections and suggesting changes to an existing supplier-customized catalogue (col. 17, lines 46-48), but this activity is not done as a part of generating the catalog, but rather is merely a way to make *suggested changes* to the pre-existing supplier-generated catalog (col. 17, lines 49-51). It is the supplier who ultimately decides whether to accept or reject such proposed changes (col. 18, lines 6-32). The reference also describes an ability for a buyer to create sub-catalogs, but these sub-catalogs are generated using pre-existing and previously contracted items (col. 20, line 64 – col. 21, line 9). This allows to buyer to combine a plurality of items from pre-existing contracts from different suppliers into a single catalog, for ease of use by the buyer's procurement department (col. 21, lines 10-16). Thus, there is no 'negotiating' with respect to items placed in this sub-catalogue, as the items in this sub-catalogue have already been contracted. Claim 23 explicitly recites "*negotiating terms for purchasing items in the customized catalog*". Thus, it is urged that this teaching of a buyer generated sub-catalogue also does not teach the missing claimed steps identified above, as the items in this sub-catalogue have already been negotiated as the contract is already in place.

In summary, as every element of the claimed invention is not identically shown in a single reference, it is urged that Claim 23 is not anticipated by the cited reference.

Applicants traverse the rejection of Claims 47, 71 and 95 for similar reasons to those given above with respect to Claim 47.

Therefore, the rejection of Claims 23, 47, 71 and 95 under 35 U.S.C. § 102(e) has been overcome.

III. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 24, 48, 72 and 96 under 35 U.S.C. § 103 as being unpatentable over Hare in view of Official Notice. This rejection is respectfully traversed.

With respect to Claim 24, Applicants initially traverse this rejection for similar reasons to those given above with respect to Claim 23 (of which Claim 24 depends upon).

Further with respect to Claim 24, the Examiner acknowledges that the features recited in such claim are not taught by the cited reference, but states that these claimed features are well-known. Applicants urge that whether something is 'well-known' is not a proper basis for making a rejection under 35 USC 103. As stated by the Federal Circuit, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). It is thus shown that the Examiner's assertion that the missing claimed features recited in Claim 24 are 'well-known' is an improper reason/basis for making an obviousness rejection. Thus, Claim 24 is shown to have been erroneously rejected using such 'well-known' reasoning.

Further with respect to Claim 24, such claim specifically recites the claimed feature of "establishing operational items including at least one service level agreement for purchasing the items pursuant to the negotiated terms". As can be seen, this claimed feature is directed to details for actually purchasing items pursuant to negotiated terms, which is in addition to the pre-sales activity defined in Claim 23. As claimed in Claim 23, and as defined in the preferred embodiment in Applicants' Specification at page 9, line 26 – page 10, line 25, a user meta-shops to place items in a set in order to generate a customized catalogue that can be used for possible future purchases by the entity represented by the user. The items are not bought at the present time, but rather these items are items that the entity may be interested in potentially buying at a later time (Specification page 10, lines 17-22). Because of such pre-screening or pre-selection of items to be included in a customized catalogue, there is no reason or other motivation to also provide or include a service level agreement with respect to the actual purchasing/buying of such items. Restated, a service level agreement pertaining to the actual purchase of items does not necessarily flow from the pre-screen/pre-selection process recited in Claim 23. Rather, such service level agreement is an additional agreement over and above the terms that were negotiated for purchasing items in the customized catalogue. The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is simply no suggestion in the cited reference of any desire to modify the teachings contained therein in accordance with the features recited in Claim 24. Thus, per *In re Gordon*, Id., it is shown that the mere fact that the cited reference could be modified in accordance with the claimed invention is not a basis for an obviousness rejection. Therefore, it is further urged that Claim 24 is not obvious in view of the cited reference.

Applicants traverse the rejection of Claims 48, 72 and 96 for similar reasons to those given above with respect to Claim 24.

Therefore, the rejection of Claims 24, 48, 72 and 96 under 35 U.S.C. § 103 has been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over the cited reference and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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